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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,246	09/26/2001	F. William Daugherty	102.006	8590
8791 7590 07/24/2008 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
07/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/963,246

Applicant(s)

DAUGHERTY ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/02)
Paper No(s)/Mail Date 5/22/08, 5/23/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the paper(s) filed 5/22/08.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-10, 12, 17, 19- 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Chamberlain (US20030208369).**

Chamberlain includes benefit to provisional US application 60/231298 (filed 9/8/2000) and cited/included herein

Regarding claims 1, 2, 4, 5, 9, 12, 17, 19, 20, 26, 27, Chamberlain teaches a website including a banner advertisement that includes user selectable fields. Each field is associated with an information delivery channel. The user may select email, FAX, mail, phone, etc. The user selects this field, provides his contact information (i.e. consents to information receipt) and the business will then provide further information about the advertisement/product over this channel to the requesting consumer [page 1 of provisional, figs 5, 8 of provisional].

Regarding claim 3, the information delivered provides an indication of the personal information used by way of the channel that the consumer gets the information.

Regarding claims 6-8, 10, providing a parcel/letter to the US Postal Service for example for delivery to the identified recipient is taken to be providing a third party with the personal/contact information of the consumer as well as an indication of the consumer's choice to have a postal delivery for them.

Regarding claims 21-24, and the "third-party" language, the website providing the product information and user form to request information can be taken to be the third party, while the consumer is taken to be a first party and the consumer's ISP for example could represent a second party, enabling access to the Internet and the third-party website. A consumer choosing the selectable option of a telephone number provides the steps of providing to the third party an indication of the selection and the requested delivery process.

Regarding claim 25, Chamberlain's fig 5 of the provisional is taken to teach a third party banner ad on the www.news.com website. Interacting with the 3rd party banner is taken to include delivery of the consumer's contact information to the website of the advertiser so that the requested advertiser information can be delivered to the requesting consumer.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chamberlain in view of Patterson (US2003/0028608).

Regarding claims 11, 14-16, Patterson also teaches a user of a webpage filling out a text field with contact information so that the business who is advertising can contact that consumer through the specified communication channel and unique communication address provided [para 0026]. Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a confirmation notice that the information will be provided via the communication channel, such as for example by third party US Postal Service.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

[NOTE: the following is a repeat of previous rejections as alternative rejections]

2. **Claims 1-10, 12, 17-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg (US6330243).**

Regarding claims 1, 2, 4, 17-20, 26, 27, Stranberg teaches that it is well known for consumers to request product information from a business via the World Wide Web and for the business to provide a field for the inquiring party to provide a telephone number where they can be contacted for further information and follow-up [col 1: lines 28-46]. Stranberg also teaches the concept of a user accessing a webpage from a website via a web browser where the webpage can include various content such as text, images, audio, video, etc. as well as an HTML-based user interface with data entry capability. The HTML interface serves to advertise that more information about a product/service is available upon request and is therefore taken to meet the broad term "advertisement" as well as the term "item" [col 5: lines 7-8, lines 16-35]. The data entry fields of the interface are designed to elicit responses to requests for product information as is well known in the art" [5:24-26]. Such requests can include name, telephone, address, information desired, product inquiries or any other information useful for sales and/or marketing purposes [5:27-31]. While Stranberg admits it is known to contact an inquiring consumer via a submitted telephone number in order to provide the requested product information, Stranberg is silent on whether to contact the inquiring consumer according to the other collected information fields such as address. However, It would have been obvious to one of ordinary skill at the time of the invention to have provided any number of plural contact field options (postal mail, FAX, telephone, cell phone, email, etc. as they are well known methods of communication – and in some cases, *electronic* communication), to have collected the appropriate number, address, email, etc. and to have contacted the inquiring party by such

requested communication channels in order to deliver the desired product information. Doing so would allow consumers to receive the requested information in a format they find most comfortable, digestible and convenient – including an *electronic* delivery transmission method. Each of the plural fillable fields of Stranberg's interface is taken to represent a "selectable" option.

Regarding claim 3, receiving a FAX, email, telephone call, postal mailing, etc inherently represents receiving an indication of personal information used to make such communication contact.

Regarding claims 5, 9, any of the received information about the consumer is taken to be personal information.

Regarding claims 6-8, 10, providing a parcel/letter to the US Postal Service for example for delivery to the identified recipient is taken to be providing a third party with the personal/contact information of the consumer as well as an indication of the consumer's choice to have a postal delivery for them.

Regarding claim 12, it would have been obvious to one of ordinary skill at the time of the invention to have asked for consent to send future communications to the consumer in order to deliver future promotional materials as is well known. Doing so would serve to create a long-term relationship with the consumer.

Regarding claims 21-24, and the "third-party" language, the website providing the product information and user form to request information can be taken to be the third party, while the consumer is taken to be a first party and the consumer's ISP for example could represent a second party, enabling access to the Internet and the third-

party website. A consumer choosing the selectable option of a telephone number provides the steps of providing to the third party an indication of the selection and the requested delivery process.

Regarding claim 25, a consumer requesting information to be sent to his email address meets the claim in the case where the consumer reads his email via a website (webmail client). Official Notice is taken that webmail (such as Yahoo mail and Microsoft's hotmail) has been around for years. It would have been obvious to one of ordinary skill at the time of the invention to have checked the consumer's email from such a webmail service. Reading an email on a webmail site about requested product information can be said to represent an indication of the email-selection as the delivery method.

3. Claims 11, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg in view of Patterson (US2003/0028608).

Regarding claims 11, 14-16, Patterson also teaches a user of a webpage filling out a text field with contact information so that the business who is advertising can contact that consumer through the specified communication channel and unique communication address provided [para 0026]. Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a confirmation notice that the information will be

provided via the communication channel, such as for example by third party US Postal Service.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

4. Claims 6, 10, 11, 13-16, 21-25 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg in view of Patterson and/or Patterson in view of Stranberg.

Regarding claims 6, 10, 21-25, Patterson teaches that a consumer (i.e. first party) can visit a first website (i.e. second party) which can include not only content about the first business, but also a banner advertisement from a second business (i.e. third party). The advertisement is taught to include a request form that the user can fill out such as "send me information on golf clubs" [para 0026]. The form can collect the user's email address as contact information as well as userID [para 0037]. It would have been obvious to one of ordinary skill at the time of the invention to have provided the plurality of contact options in a manner made obvious by Stranberg with the third party advertisement of Patterson. Doing so would enable web surfers at many various websites to see and request the product information of Stranberg; this provides wider exposure for the third party. A consumer filling out a particular selectable option with his personal contact information results in an indication to the third party of the consumer's desire for information and the requested delivery channel and would trigger the delivery

of such information via the proper communication channel (email, telephone, FAX, postal mail, etc.).

Regarding claims 11, 14-16, Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028, figure 4]. This message serves to indicate that the third party will be delivering the requested information.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that the data entry fields of Stranberg are not associated with different information delivery processes. Stranberg clearly teaches to provide input fields whereby users can request delivery of desired information; Stranberg teaches that user's can submit their telephone number and address. One of ordinary skill would find it obvious to enable users to request information be sent via any well known communication channel including email, IM, FAX, cell phone, postal mail, telephone, web download, etc. A user inputs a request along with his email address in the proper field and he gets an email; a request and his FAX number and he gets a FAX, Etc. Applicant argues that Stranberg teaches away from multiple contact channels. This is not true. While Stranberg does see the importance of immediate (chat) contact with a customer who is currently using their phone to dial-into the website, Stranberg does not

teach that other channels cannot also be offered. One of ordinary skill would see that there are many types of consumers who desire information delivered differently. It would have been obvious to one of ordinary skill at the time of the invention to have provided not only the instant chat contact of Stranberg, but also other means such as telephone calls, FAXes, USPS mail, etc. Many consumers will not have PCs equipped with multimedia (speakers, microphone) in order to do the chat. Many consumers would prefer to get a hard copy in the mail so that they could consider the products/offerings on their time and with their spouse at a later time. Why would one of ordinary skill not serve all types of users? Stranberg also teaches that chatting is not a requirement, it is only optional [col 5 line33-35]. The various means of contacting a consumer need not conflict with each other – they are not mutually exclusive. The reference does not therefore teach away from the suggestion in the rejection.

Applicant argues that while Stranberg collects user contact information, it is up to the business to choose to contact via that channel. Applicant's arguments that such contact (which happens all the time) does not provide "user-selection" of a contact option. It can be said that providing an email address is in itself a selection as well as an approval for delivery of information through that channel. Same goes for providing a FAX number, etc. It is not clear how applicant's statement that "the website provider chooses how to provide any additional information to the user" does anything other than support the examiner's viewpoint.

Regarding claim 25, examiner stands behind his reasoning that reading an email on a webmail site about requested product information can be said to represent an indication of the email-selection as the delivery method.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 3622

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